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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,203	04/07/2004	Yutaka Konomura	P/2850-94	7409
2352 7590 09/03/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER LEUBECKER, JOHN P				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,203

Applicant(s)

KONOMURA ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

1. Newly submitted claim 28 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention of claim 28 is related to the originally claimed invention (e.g., claim 3) as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by an apparatus with a reading section that is not at the tip of the endoscope, a feature that was required in the originally elected invention. In addition, the apparatuses as now claimed in claims 3 and 23 can be used in a process to only verify that a correct adapter is used with the correct endoscope or to only register components at first use, and thus does not require determining of a positional error, correction of data, coordinate transformations or any kind of stereo measurement whatsoever.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 28 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Regarding Applicant's "correction" of the Response to the Requirement for Restriction/Election, it is noted that no correction was necessary or is now allowed. Applicant elected Group I and Species I, which were correctly identified as claims 1-7. These are the

claims that were examined. Applicant can not withdraw or change the selection of the Group or Species that was originally selected. It is noted that such election was treated as an election without traverse (note numbered paragraph 1 of the previous Office Action, paper number 20071226). Accordingly, claims 8-12 are still withdrawn.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “screen of the optical adapter” (claims 1, 3, and 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 3 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 3 and 24 now recite a "screen of the optical adapter". The specification fails to mention that the optical adapter has a screen, or fails to provide any indication as to what this element is referring.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1-7 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tohjoh et al. (U.S. Pat. 4,856,495) in view of Heinrichs et al. (U.S. Pat. 6,092,722).

As to claims 1, 3 and 23-25, Tohjoh et al. disclose an endoscope insertion section (4) having a light receiving section at the tip (36,38 but could also include imaging chip 122, Fig.4), an optical adapter (16) detachably installed at the tip and having an optical system (19) which forms and image in the light receiving section. Tohjoh fails to disclose an information device containing information installed in the optical adaptor and a reading section installed in the tip of the endoscope insertion section that obtains the information.

Heinrichs et al. teaches placing information devices (33, Fig.1) in components (30b,30a,18) of an endoscope system that are connected together so as to not only identify (e.g., with serial numbers), but to transmit characteristic information so that a control unit can automatically adapt to the characteristics of different components (e.g., col.5, lines 23-36), which can be considered a calibration process. This is done with a reader (20, Fig.1) in a proximate component and connected to a control unit (15, col.5, lines 2-4). It would have been obvious to one of ordinary skill in the art to have provided an information device in the optical adaptor of Tohjoh to identify and allow the a control unit to adapt to that particular optical adaptor in view of the teaching of Heinrichs. Since operational proximity of the information device allows for reading of the information by an adjacent component (note col.5, lines 50-56), the reader would need to be at the distal end of the insertion section (4) of Tohjoh. One of ordinary skill in the art could have combined the elements as claimed using the methods taught by Heinrichs and such combination would have yielded the predictable result of allowing identification and adaptation of the system in accordance with the particular optical adapter being used.

In addition, Tohjoh et al., in view of Heinrichs, does not expressly show the information as identifying an angle of view or coordinates of a center of a screen. However, this difference is

only found in the nonfunctional data stored on the information device¹. Data identifying an angle of view or coordinates of a center of a screen is not functionally related to the apparatus. Thus, this data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to store any data in the information device of Tohjoh et al./Heinrichs because such data does not functionally relate to the device and merely labeling the data differently from that of the prior art would have been obvious.

Further as to claim 23, it appears that information, including serial numbers and regulating/optical characteristics (col.5, lines 27-36), is only read by the reading section once in Heinrichs, and stored in the control unit (col.4, line 64 to col.5, line 4). After that, the automatic adaptation of such actions as imaging (which can be considered a measurement process—measurement of light characteristics) is carried out without further reading. Thus, information is capable of being stored in a memory of the control unit and applied to a measurement process without being read by the reading section.

As to claims 2, 4 and 5, the information device can be an IC chip (col.5, lines 57-63) and the information can be transmitted wireless through antennae (e.g., coils described in col.5, lines 37-47). As to claims 6 and 7, the coils described in col.5, lines 37-47 constitute "joining

¹ The specific data is not functionally related to the information device, or any other structure of the invention. Rather it is just being held in the information device. As a result, this data can be called nonfunctional descriptive material and does not limit the claim.

terminals" and the "connection" as claimed is met with the electromagnetic energy transmitted between them. Note that claims 6 and 7 do not explicitly require the terminals to "touch". As to claims 26 and 27, besides being able to calibrate and store information, the control unit is capable of changing data (col.3, lines 8-13) which would anticipate generation of data containing information. Furthermore, the control unit could include a computer (col.4, lines 16-19), which is also capable of generating data and storing it.

Response to Arguments

8. Applicant's arguments filed May 20, 2008 have been fully considered but they are not persuasive.

As pointed out above, nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Furthermore, other newly added limitations are nothing more than functional capabilities of any control unit (computer) which are addressed above. The Examiner suggests the addition of structural limitations to distinguish over the prior art.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Leubecker/
Primary Examiner
Art Unit 3739